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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY, DOCKET NO.	CONFIRMATION NO.
09/322,067	05/27/1999	JEFFREY SKOLNICK	10886/047001	7470

20985 7590 03/05/2003

FISH & RICHARDSON, PC  
4350 LA JOLLA VILLAGE DRIVE  
SUITE 500  
SAN DIEGO, CA 92122

EXAMINER

BORIN, MICHAEL L

ART UNIT PAPER NUMBER

1631

DATE MAILED: 03/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/322,067**

Applicant(s)  
**Skolnick et al**

Examiner  
**Michael Borin**

Art Unit  
**1631**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 23, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3, 5-10, 12-14, 16-20, 22, 45, 46, 48-50, 52-54, 56, 58, 59, and is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 3, 5-10, 12-14, 16-20, 22, 45, 46, 48-50, 52-54, 56 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **Part III DETAILED ACTION**

Response and amendment filed 12/23/02002 is acknowledged.

Claims 2,4,11,44,47,51,55,57,60 are canceled. Claims 61-116 are added.

Upon consideration of the claims, the following restriction of the presented set of claims is deemed necessary:

#### **Restriction Requirement**

Restriction to one of the following inventions is required under 35 U.S.C. 121 (note: only independent claims are listed below; grouping of dependent claims<sup>1</sup>, can be found on pages 28-30 of the response) :

- I. Claims 53,59,20 drawn to a descriptor of a functional site of a protein.
- II. Claims 45,54,56,58,92,105,106 drawn to methods of creating or defining or determining <sup>2</sup> of a descriptor of a functional site of a protein.
- III. Claim 104, drawn to a computer system.

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<sup>1</sup>although erroneous in several instances

<sup>2</sup>All of the methods of creating or defining or determining recite same method steps

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The inventions are distinct, each from the other because of the following reasons:

Inventions of groups drawn to methods of creating or defining or determining of a descriptor of functional site of a protein are related to Group I as methods of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the processes as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be obtained/identified by another and materially different processes, e.g., derived from crystallography description of a protein.

Groups III is unrelated to Group I as it does not require the particular functional site descriptor of Group I. Even if it had, Groups I (product) and III (method of use) would be patentably distinct, as the product of Group I can be used in processes (or systems) other than the system of Group III. In regard to Groups II and III, the Groups are distinct as related as method of making and method of using of a product.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

If applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. (MPEP 821.04)

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703)

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305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Mr. Michael Woodward, can be reached at (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

March 3, 2003

MICHAEL BORIN, PH.D.  
PRIMARY EXAMINER

mlb

A handwritten signature in black ink, appearing to read 'Michael Borin', is written over the printed name and title.